

Appl. No. 10/070,791
Election With Traverse dated 8-18-2004
Reply to Restriction Requirement of 5-18-2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/070,791 Confirmation No. 9473
Applicants : Piet Herdewijn et al
Filed : August 5, 2002
Title : Carbocyclic Nucleosides and Process for Obtaining Such
Art Unit : 1624
Examiner : Mark L. Berch
Docket No. : 702-020249
Customer No. : 28289



ELECTION WITH TRAVERSE

Sir:

This is in response to the Office Action dated May 18, 2004 in which the Examiner required a restriction to one of the following inventions:

Group I: those parts of claims 1-10, 12, 14, 15-23 and 37-45 that are drawn to adenines;

Group II: claim 13 and those parts of claims 1-10, 12, 14, 15-23 and 37-45 that are drawn to guanines;

Group III: those parts of claims 1-10, 12, 15-23 and 37-45 that are drawn to diaminopurines;

Group IV: those parts of claims 1-10, 12, 15-23 and 37-45 that are drawn to hypoxanthines;

Group IV: those parts of claims 1-10, 12, 15-23 and 37-45 that are drawn to xanthines;

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Diane Paull

(Name of Person Mailing Paper)

Diane Paull
Signature

8/18/2004
Date

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Group V: those parts of claims 1-9, 14, 15-23 and 37-45 that are drawn to 2-amino-6-Cl-purines;

Group VI: claim 11 and those parts of claims 1-9, 11 and 12 that are drawn to other heterocycles; and

Group VII: claims 24-35, drawn to non-heterocyclic cyclohexene, cyclohexadiene or benzene triols or derivatives thereof.

Applicants respectfully point out that the Groups are incorrectly numbered, and thus there should be eight Groups.

Applicants hereby elect for further prosecution Invention Group I, covering those parts of claims 1-10, 12, 14, 15-23 and 37-45 that are drawn to adenines.

Applicants respectfully traverse the restriction requirement on the grounds that under the Patent Cooperation Treaty (PCT), an Examiner is not allowed to raise a non-unity objection after the application has entered the national phase and where in the international phase no such objection has been raised. In particular, in the PCT Applications Guide, paragraph 138, it is stated that "an international application which complies with the unity of invention requirements laid down in Rule 13, must be accepted by all the designated and elected offices since Article 27.1 does not allow any national law to require compliance with requirements relating to the contents of the international application different from or additional to those provided in the PCT."

Because the international application that corresponds with the present application complies with the unity of invention as determined by the international Examiner, Applicants respectfully submit that the restriction requirement issued by the Examiner is not valid and should be rescinded.

In the event that the Examiner continues to maintain the restriction requirement, Applicants point out that the general inventive concept linking the molecules of the present invention is not the nucleobase part B, as asserted by the Examiner, but rather is the unsaturated cyclohexenyl moiety (cyclohexenyl). The cyclohexenyl moiety is very important for providing the activity of the claimed compounds. In particular, the biological activity of the claimed compounds comes from the sugar analogue part of cyclohexenyl and not from the use of the nucleobase. In this regard, comparison can be made with other anti-viral compounds, such as 3'-azido-3'-deoxythymidine (AZT) and 3'-thai-2', 3'-dideoxycytidine (3-TC), which are all

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nucleotide analogues with modifications in the sugar part of the compound, similar to the compounds of the present invention. Furthermore, AZT and 3-TC also have nucleobases but differ in their sugar moieties.

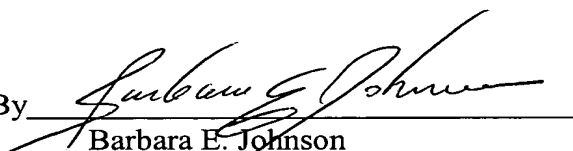
Applicants hereby reserve the right to prosecute the non-elected claims by way of a divisional application filed at a later time. Pursuant to 37 C.F.R. § 1.48(b), there is no change in inventorship as a result of this Election.

A Petition for Two-Month Extension of Time accompanies this Election With Traverse.

Respectfully submitted,

WEBB ZIESENHEIM LOGSDON
ORKIN & HANSON, P.C.

By



Barbara E. Johnson
Registration No. 31,198
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818
Telephone: 412-471-8815
Facsimile: 412-471-4094